1642

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Junming Le, Jan Vilcek, Peter Daddona, John Ghrayeb, David M. Knight and Scott Siegel

Application No.: 09/756,301 Group Art Unit: 1642

Filed: January 8, 2001 Examiner: Canella, K.

For: ANTI-TNF ANTIBODIES AND PEPTIDES OF HUMAN TUMOR NECROSIS FACTOR

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, P.O. Box 2327, Arlington, VA 22202

on 4-26-02 (Date) Linda M. Crawford (Signature)

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REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
P.O. Box 2327
Arlington, VA 22202

Sir:

Responsive to the Restriction Requirement dated March 26, 2002, the claims of Group I (Claims 1-15 and 17-55) drawn to chimeric antibodies, polypeptides and fusion proteins which bind to TNF-alpha, are provisionally elected for prosecution.

The election is made with traverse. In particular, the requirement set forth in the action mailed on March 26, 2002, improperly sets forth Group I and Group II as independent and patentably distinct from each other. The claims of these groups are related as a combination/subcombination. MPEP 806.05(c) requires that two-way distinctness needs to be demonstrated where the inventions are related in this manner. Restriction between a combination/subcombination is proper where (1) the combination as claimed does not require the particulars of the subcombination and (2) the subcombination has utility by itself or in other combinations. In this case, the combination of Claim 16 (of Group II) requires the particulars of the subcombination of Claim 36 (of Group I). Thus, the chimeric antibody of Claim 36

constitutes the essential distinguishing feature of Claim 16. Example II in the MPEP 806.05(c) states that where the relationship between the claims is such that the separately claimed subcombination constitutes the essential distinguishing feature of the combination as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility. As such, these claims do not satisfy the two way distinctness test. Therefore, Group I and II should be joined as a single group.

Furthermore, the examination of Group I and II together would not result in an undue burden upon the Patent Office, since the search of the chimeric antibody (Group I) would necessarily cover the process of using the chimeric antibody (Group II). Thus, there is no excessive searching burden to the Examiner to combine the two restricted groups into a single group. For the above reasons, withdrawal of the restriction requirement is respectfully requested.

If the grounds of traversal do not result in withdrawal of the restriction requirement, then Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

Claims 16 and 33 are drawn to an immunoassay method for detecting human TNF, however, only Claim 16 was restricted into Group II. For the reasons stated above, Claim 33 should remain in Group I. Reconsideration and withdrawal of the restriction requirement are respectfully requested.

An Information Disclosure Statement (IDS) was filed on March 29, 2002. Entry of the IDS is respectfully requested.

Respectfully submitted,
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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